

## REMARKS

### A. Objections to Drawings

In the Office Action mailed on March 4, 2003, the drawings were objected to for lacking labels. FIGS. 1-2 have been amended to include the labels in the boxes. Accordingly, the objection has been overcome and should be withdrawn.

### B. 35 U.S.C. § 112, First Paragraph

Claims 110-115 were rejected under 35 U.S.C. § 112, first paragraph, for not being described in the specification so as to enable one of ordinary skill to make and/or use the claimed invention. Applicants traverse this rejection. The originally filed specification at, for example, pg. 11, line 27 – pg. 12, line 8, provides disclosure supporting this feature. Also, original claim 9, which is part of the original description, describes the invention of claim 110 in sufficient detail to enable the invention for one of ordinary skill in the art. Accordingly, the rejection is improper and should be withdrawn.

### C. 35 U.S.C. § 102

#### 1. Claims 30-46, 99-109 and 116

Claims 30-46, 99-109 and 116 were rejected under 35 U.S.C. § 102 as being anticipated by Agraharam et al. Applicants traverse this rejection. Independent claims 30 and 99 recite "identifying elements." In other words, the claims recited more than one identifying element. In contrast, Agraharam et al. only discloses entering a telephone number of the user whose email address is wanted. Thus, Agraharam et al. discloses using only one identifying element, which is in contrast with claims 30 and 99. Accordingly, claims 30 and 99 are not anticipated by Agraharam et al. and so the rejection is improper and should be withdrawn.

Besides not being anticipated by Agraharam et al., claims 30 and 99 are not rendered obvious by Agraharam et al. since there is no suggestion for entering anything other than a telephone number of the user. Clearly, Agraharam et al. does not recognize the flexibility advantage in having a plurality of identifying elements as Applicants have recognized. Without suggestion to have a plurality of identifying elements, claims 30 and 99 and their dependent claims are patentable over Agraharam et al.

Note that claims 30 and 99 have been amended to clarify that there are a “plurality” of identifying elements. Since the amended phrase “plurality of identifying elements” is identical in meaning and scope with “identifying elements” as originally recited in the claims, the amendment is not being made for reasons of patentability as defined in *Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 234 F.3d 558, 56 USPQ2d 1865 (Fed. Cir. 2000) (*en banc*), *overruled in part*, 535 U.S. 722, 122 S. Ct. 1831 (2002).

Note that the amendment of claim 30 that replaces “is a combination of one or more” with “comprises at least one” is being made to clarify and broaden Applicants’ invention. Accordingly, the amendment is not being made for reasons of patentability as defined in *Festo*.

## **2. Claims 47-98 and 117**

Claims 47-98 and 117 were rejected under 35 U.S.C. § 102 as being anticipated by Agraharam et al. Applicants traverse this rejection. Independent claims 47, 64 and 81 have been amended to clarify that there are a plurality of identifying elements. As

pointed out above in Section C.1, Agraharam et al. does not disclose using a plurality of identifying elements. Accordingly, the rejection is overcome and should be withdrawn.

Besides not being anticipated by Agraharam et al., claims 47, 64 and 81 are not rendered obvious by Agraharam et al. since there is no suggestion for entering anything other than a telephone number of the user. Without such suggestion, claims 47, 64 and 81 and their dependent claims are patentable over Agraharam et al.

### **3. Claims 110-115**

Claims 110-115 were rejected under 35 U.S.C. § 102 as being anticipated by Agraharam et al. Applicants traverse this rejection. Independent claim 110 recites “placing numeric characters of a number of a telecommunications device of the user within at least one portion of said email address.” Agraharam et al. does not disclose such a placing and so the rejection is improper and should be withdrawn.

Besides not being anticipated by Agraharam et al., claim 110 is not rendered obvious by Agraharam et al. since there is no suggestion for placing numeric characters of a number of a telecommunications device of the user within at least one portion of said email address. Without such suggestion, claim 110 and its dependent claims are patentable over Agraharam et al.

### **CONCLUSION**

In view of the arguments above, Applicants respectfully submit that all of the pending claims 30-117 are in condition for allowance and seeks an early allowance thereof. If for any reason, the Examiner is unable to allow the application in the next Office Action and believes that an interview would be helpful to resolve any

remaining issues, he is respectfully requested to contact the undersigned attorneys at  
(312) 321-4200.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Kent E. Genin", written over a horizontal line.

Kent E. Genin  
Registration No. 37,834  
John C. Freeman  
Registration No. 34,483  
Attorneys for Applicants

BRINKS HOFER GILSON & LIONE  
P.O. BOX 10395  
CHICAGO, ILLINOIS 60610  
(312) 321-4200

Dated: September 4, 2003

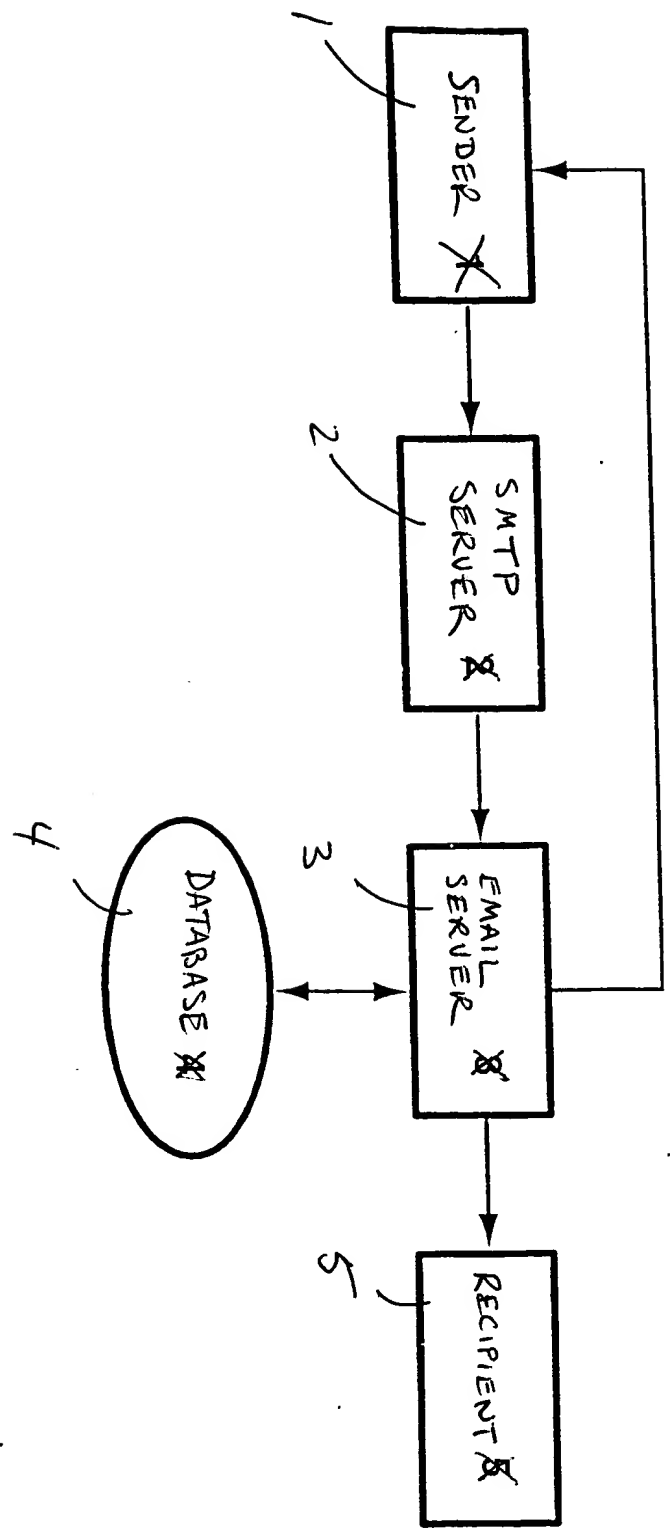


Figure 1

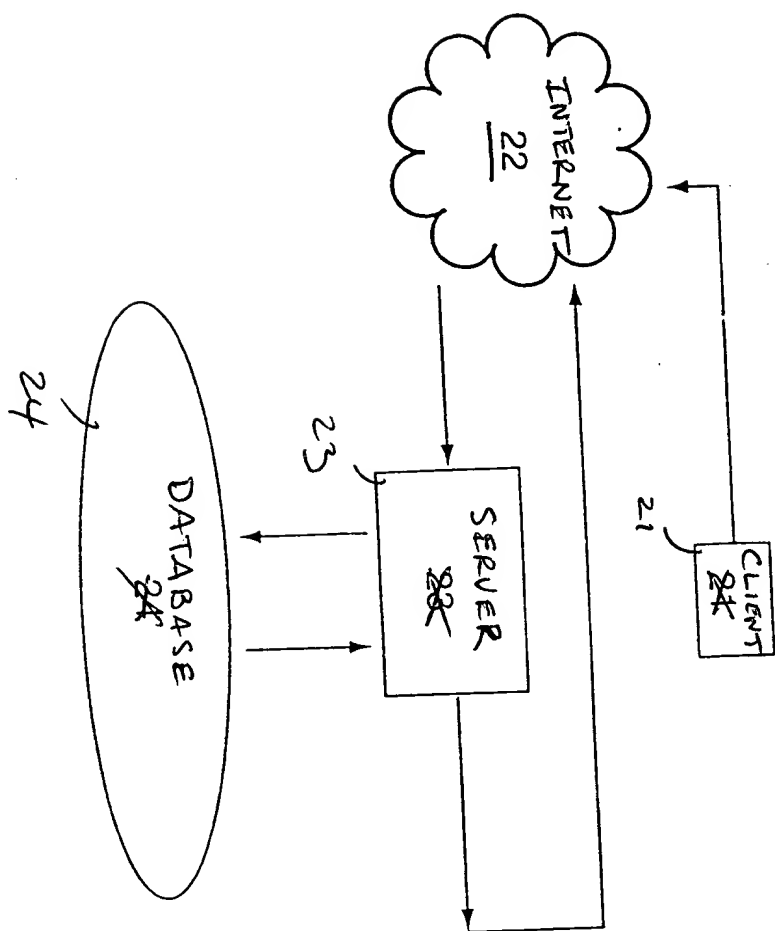


Figure 2